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BACON & THOMAS, PLLC			EXAMINER	
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The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/532,666
Filing Date: April 17, 2006
Appellant(s): VON STEIN ET AL.

Felix J. Ambrosio (Reg. 25,721)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/27/2009
appealing from the Office action mailed 07/28/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,959,356	Packwood et al.	10-2005
6,754,710	McAlear	6-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Packwood et al. (US 6,959,356), herein after referred to as Packwood et al. '356 in view of McAlear (US 6,754,710), herein after referred to as McAlear '710.

Referring to **claim 4**, Packwood et al. '356 teaches, as claimed, a method for parametering a first field device in process automation technology connected with a fieldbus (i.e.-method for communicating field devices connected with a field bus, col. 4, lines 10-15), comprising the steps of: providing a second field device connected with the fieldbus (i.e.-smart field devices

22/24/26, see fig. 1) and providing an on-site operating means connected to the second field device (col. 4, line 66 - col. 5, line 3).

However, Packwood et al. '356 does not teach the steps of activating a remote parametering mode at said on-signed operating means; selecting the first field device to be remotely parametered; accessing of an operating and display software of the first field device from the second field device; and exchanging parametering data via the fieldbus with the first field device to be parametered.

On the other hand, McAlear '710 discloses a remote control software called Timbuktu Pro which allows a user to control another device across local network by using its keyboard and mouse as if the operator is sitting in front of it.

Thus, at the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Packwood et al. '356 and implement the steps, such as, selecting the first field device to be remotely parametered; accessing of an operating and display software of the first field device from the second field device; and - exchanging parametering data via the fieldbus with the first field device to be parametered, as taught by McAlear '710 because it allows to control/configure/operate remotely placed devices. The motivation for doing so would have been to alleviate problems/costs associated with the need of an operator or a user to be physically present in the proximity of remotely located devices.

As to **claim 5**, Packwood et al. '356 teaches the method as claimed in claim 4, further comprising the step of: exchanging

the parametering data in a proprietary protocol, which is built on top of a fieldbus protocol (HART, PROFIBUS, FOUNDATION FIELDBUS) (col. 3, lines 5-14).

As to **claim 6**, Packwood et al. '356 teaches the method as claimed in claim 4, further comprising the step of: exchanging the parametering data in a fieldbus protocol (HART, PROFIBUS, FOUNDATION FIELDBUS) (col. 3, lines 14-29).

(10) Response to Argument

I.

Appellant argues, McAlear does not disclose that one field device has an on-site operating means, which is certainly not a PDA or a keyboard or a mouse. That means that not every field device has an on-site operating means.

Examiner disagrees with the Appellant. McAlear discloses a software program which allows to access a remotely located computer (i.e.-target computer) using a personal computer as a controlling computer (col. 2, lines 6-21). Further, McAlear also discloses that the device used as a remote control, needs to be a computer with an on-site operating means such as a keyboard, a mouse and a display (col. 2, lines 40-45). Furthermore, it appears that Appellant is arguing a limitation not claimed in any of the claims. The claim language does not say "every field

device has an on-site operating means" which is not addressed in the art rejection of the outstanding final Office Action.

II.

Appellant argues, McAlear fails to disclose that a second field device in the fieldbus structure is parameterized via the on-site operating means of the first field device. These distinctions are important to the invention and neither Packwood or McAlear disclose them.

Examiner disagrees with the Appellant. First, claim 4 states that the first field device being parameterized via the on-site operating means of the second field device but not the second field device is parameterized via the on-site operating means of the first field device. Second, the Examiner did not cite McAlear for this claimed feature.

Packwood et al. discloses a second field device in a fieldbus structure. (Col. 5, lines 15-31 and see fig. 1).

McAlear discloses a method of remotely directing a computer activity from a controlling computer (personal computer) by using its on-site operating means such as keyboard, mouse and display unit (col. 2, lines 15-21 and lines 40-45).

Therefore, the combined teachings of Packwood et al. and McAlear disclose the claimed feature; a first field device in the fieldbus structure is parameterized via the on-site operating means of the second field device.

Furthermore, the Appellant argument appears to be attacking the cited prior arts individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See IN RE KELLER, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); IN RE MERCK & CO., 800 F.2d 1091, 231 USPQ 375 (FED. CIR. 1986).

III.

Appellant argues, it is difficult to see how or why Packwood et al. and McAlear are combinable. One deals with a process control system including multi-protocol field devices (Packwood et al.), whereas the other deals with the remote control of a computer network (McAlear). The problems that each addresses are different and the solutions are tailored to the problem addressed. Neither patent shows or suggests the claimed steps of claim 4 as a solution to the problems faced by applicants.

Examiner disagrees with the Appellant. The question whether a reference is analogous art is irrelevant to whether that

reference anticipates. See *In re Self*, 671 F.2d 1344, 1350, 213 USPQ 1, 7 (CCPA 1982). A reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims. (*In Re Schreiber*, 44 USPQ2d 1429). Moreover, it is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a *prima facie* case of obviousness. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

IV.

Appellant argues, why would the person skilled in the art consider the teaching of McAlear when he starts with Packwood et al., given the differences in the two discourses.

Examiner disagrees with the Appellant. Packwood et al. discloses the configuration of smart field devices from a central location such as a host system or workstation within the process control system or, alternatively, locally at the field devices using a portable configuration tool such as a personal computer (col. 1, lines 54-61 and col. 2, lines 54-61).

McAlear discloses a software program which allows access to a computer (target computer) from a controlling computer (col. 2, lines 6-13). In operation, the controlling computer has a program window open, which mirrors the display screen of the target computer. Operations performed within this window are transmitted and acted upon by the target computer as if the operations were transpiring at the target computer (col. 2, lines 15-19).

Therefore, a person of ordinary skill in the art would consider the teaching of McAlear because it enables to access the operating and display software of a first field device (i.e.-target computer) from a second field device (i.e.-controlling computer) in order to control/configure/operate remotely placed devices. The motivation for doing so would have been to alleviate problems/costs associated with the need of an

operator or a user to be physically present in the proximity of remotely located devices.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/E. M./

Examiner, Art Unit 2184

Conferees:

/Kevin L Ellis/
Supervisory Patent Examiner, Art Unit 2117

**/Henry W.H. Tsai/
Supervisory Patent Examiner, Art Unit 2184**

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